

REMARKS

This communication is in response to the non-final Office Action issued August 6, 2004. The Examiner rejected claims 1-18 under 35 U.S.C. § 103 in view of U.S. Patent No. 5,850,808 to Burdick (Burdick) modified by U.S. Patent No. 4,861,947 to Altermatt *et al.* (Altermatt).

Interview

The Applicants thank the Examiner for conducting a personal interview on October 26, 2004. During the interview, the Examiner and the Applicants discussed the propriety of the combination of references and agreed that there were significant differences between the track of the present invention and that of the cited references.

Drawings

Formal drawings are included herewith. No changes are made relative the drawings as-filed.

Claim Rejections Under 35 U.S.C. § 103

In sections 1 and 2 of the Office Action, the Examiner rejected claims 1-18 under 35 U.S.C. § 103 in view of Burdick modified by Altermatt.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. The

modification must support a reasonable expectation of success with some degree of predictability. See, for example, MPEP § 2143.02. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicants' own disclosure. See, for example, MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy these burdens.

Burdick appears to disclose a pest repelling system including an A-shaped support housing three electrical conductors. The A-shape of the support is a "significant aspect of the invention" and is designed to avoid interference from environmental factors. See column 1, line 61 to column 2, line 8 and column 4, line 66 to column 5, line 7. The electrical conductors are provided as bare lengths of conductive wire in an effort to ensure a tight seal between the support and the conductors as an additional measure to avoid interference. See column 2, lines 62-64 and column 3, lines 5-9.

Altermatt appears to disclose a communication or control cable including a supporting element formed of a high-molecular weight. The cable includes conductors braided with the supporting element(s).

In the rejection, the Examiner stated "[i]t would have been obvious to one skilled in the art to use the electrical conductor as taught by Altermatt et al. for the conductor of Burdick since the conductor taught by Altermatt et al. provides both electrical properties and strength" (Office Action at pages 2-3). The Examiner's proffered combination, however, is in direct contrast to the stated purpose of the Burdick device to have a tight fit between the support and the conductors. The braiding of the Altermatt conductor would not provide the water tight seal sought by the Burdick. Thus, the Altermatt reference teaches away from the disclosure of Burdick; in fact, the two references are in direct contrast to each other. Therefore, their

combination under 35 U.S.C. § 103 is improper. See MPEP § 2145, which states in part “[i]t is improper to combine references where the references teach away from their combination.” See also MPEP §§ 2141.02 (prior art must be considered in its entirety, including disclosures that teach away from the claims) and 2143.01 (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

In view of the foregoing, the Examiner’s rejections under 35 U.S.C. § 103 to the claims are believed to be overcome.

Newly Added Claims

The Applicants have added new claims 19-25 to better recite certain aspects of the present invention. Claim 19 requires that the track have a substantially flat mounting surface extending substantially along the width of the track. The Applicants intend “extending substantially along the width of the track” to mean that the flat mounting surface extends along a large percentage of the track width. This is not disclosed in Burdick, which shows a mounting surface (42) that extends only along a small percentage of the track width. Claim 20 requires that the track have an arcuate surface opposite the mounting surface, with the electrical conductor being embedded within the arcuate surface. Claim 21 requires that the track is substantially unitary. Claim 22 requires there to be a plurality of electrical conductors and a mounting surface extending beneath the plurality of electrical conductors. Claim 23 requires the mounting surface to be substantially flat. Claim 24 requires the track to have a mounting surface that is designed to eliminate air gaps between the track and the surface upon which the track is mounted. This is not disclosed in the Burdick device, which has an A-shaped frame. Claim 25 requires the mounting surface to be substantially flat along a majority of the track width.

Support for these new claims is seen, for example, in figure 1. No new matter is added. These features of the track provide structural integrity. For example, the flat mounting surface and unitary track prevent the device from being crushed if force is applied against the track, for example if someone steps on it. The arcuate surface with the electrical conductor embedded therein helps prevent water from collecting adjacent the electrical conductor, which can happen if the electrical conductor is retained in the track with clips or the like.

Additional Fees

The Commissioner is hereby authorized to charge any insufficiency, including a \$45 for five additional claims, or credit any overpayment associated with this application to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 19-5127 (order no. 25062.0002).

Conclusion

Claims 19-25 have been added. Claims 1-25 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicants respectfully request reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Sean P. O'Hanlon", with a stylized flourish at the end.

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